



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/309,372	05/11/1999	KENNETH M. LASSESEN	003797.77742	7410

28319	7590	05/07/2007
BANNER & WITCOFF, LTD. ATTORNEYS FOR CLIENT NOS. 003797 & 013797 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051		

EXAMINER	
NGUYEN, MAIKHANH	

ART UNIT	PAPER NUMBER
2176	

MAIL DATE	DELIVERY MODE
05/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/309,372	Applicant(s) LASSESEN, KENNETH M.	
	Examiner Maikhanh Nguyen	Art Unit 2176	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 April 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

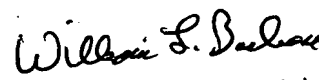
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Attached.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.


WILLIAM BASHORE
PRIMARY EXAMINER

Regarding independent claim 1:

Applicant argues in substance that the combination of Flanagan and Kennelly does not teach *"receiving the electronic file at the user's computer, wherein the electronic file's content includes a first plurality of phrases, wherein each phrase of the first plurality of phrases is expressed in a plurality of languages and has a meaning that is different than the meanings of other phrases of the first plurality of phrases regardless of the language in which said each phrase is expressed; and "at the user's computer, selecting, for display to the user, from the first plurality of phrases, a second plurality of phrases that are expressed in the language selected by the user."*

The examiner's response is as follows. Firstly, in the Office Action, the examiner mapped each claimed limitation to specific element(s) and/or relevant passages in the applied references to show how the reference meet the claim limitations. Applicant in response did not provide any underlying analysis as to why the portions of the prior art relied on did not support the examiner's position. Secondly, the combination of Flanagan and Kennelly meets the limitations as claimed. Flanagan teaches receiving the electronic file at the user's computer (*e.g., online documents from the World Wide Web/ the Web document retrieved by the browser 88*) [see fig.8 and col. 5, lines 1-16], wherein the electronic file's content includes a first plurality of phrases (*e.g., The user 84 of the multilingual browser 82 selects the desired target language (e.g. French if the user speaks French), and the Web document retrieved by the browser 88 may be rapidly translated on-the-fly with a mouse click*) [see fig. 8 and col. 5, lines 1-16]. Kennelly

teaches a first plurality of phrases, wherein each phrase of the first plurality of phrases is expressed in a plurality of languages; and a second plurality of phrases that are expressed in the language selected by the user (*e.g., system 10 displays each of the available languages in a drop down menu box 218 of page 208. (FIG. 7) Drop down menu box 218 presents all available languages in the selected language, e.g., English. Alternatively, drop down menu box 218 may present each available language in that language, e.g., drop down menu box 218 could present the English option in the English language and the Japanese option in the Japanese language. The user can select the desired language in box 218, e.g., with a mouse. If the user selects a new language other than the default language (step 302), such as Japanese, system 10 executes HTML script of page 208 and overrides the existing parameters 222) [see fig.7 and the discussion beginning at col.7, line 9 and col.9, line 4].*

Applicant argues in substance that Flanagan does not teach “*receiving the electronic file at the user's computer, wherein the electronic file's content includes a first plurality of phrases, wherein each phrase of the first plurality of phrases is expressed in a plurality of languages and has a meaning that is different than the meanings of other phrases of the first plurality of phrases regardless of the language in which said each phrase is expressed; and "at the user's computer, selecting, for display to the user, from the first plurality of phrases, a second plurality of phrases that are expressed in the language selected by the user."*

Art Unit: 2176

The examiner's response is as follows. Firstly, in the Office Action, the examiner mapped each claimed limitation to specific element(s) and/or relevant passages in the applied references to show how the reference meet the claim limitations. Again, Applicant in response did not provide any underlying analysis as to why the portions of the prior art relied on did not support the examiner's position. Secondly, Applicant is arguing against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F. 2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F. 2d 1091, 231 USPQ 375 (Fed. Cir.1986). Applicant obviously attacks references individually without taking into consideration based on the teaching of the combination of references as shown in the prior Office Action. The rejection shows how the combination of Flanagan and Kennelly meet the claim limitations.

Applicant argues in substance that Kennelly does not teach "*receiving the electronic file at the user's computer, wherein the electronic file's content includes a first plurality of phrases, wherein each phrase of the first plurality of phrases is expressed in a plurality of languages and has a meaning that is different than the meanings of other phrases of the first plurality of phrases regardless of the language in which said each phrase is expressed; and "at the user's computer, selecting, for display to the user, from the first plurality of phrases, a second plurality of phrases that are expressed in the language selected by the user."*

Again, Applicant obviously attacks references individually without taking into consideration based on the teaching of the combination of references as shown in the prior Office Action.

Regarding independent claim 6:

Applicant argues in substance that the combination of Flanagan and Kennelly do not teach *“at a receiving computer: (1) using an identifier from the plurality of identifiers, wherein the identifier corresponds to the language selected by the user, to obtain, from the respective translations in the electronic file, a translation, in the language selected by the user, for said at least one word, (2) receiving the electronic file from a sending computer, and (3) inserting the translation obtained from the electronic file into a translated electronic file.”*

The examiner's response is as follows. Firstly, in the Office Action, the examiner mapped each claimed limitation to specific element(s) and/or relevant passages in the applied references to show how the reference meet the claim limitations. Again, Applicant in response did not provide any underlying analysis as to why the portions of the prior art relied on did not support the examiner's position. Secondly, the combination of Flanagan and Kennelly meets the limitations as claimed. Flanagan teaches receiving the electronic file from a sending computer (*e.g., online documents from the World Wide Web/ the Web document retrieved by the browser 88*) [*see fig.8 and col. 5, lines 1-16*], and inserting the translation obtained from the electronic file into a translated electronic

file (e.g., *HTML document (88) in language X is translated into HTML document (90) in language Y by machine translation system 80*) [see fig.8 and col. 5, lines 1-16]. Kennelly teaches using an identifier from the plurality of identifiers, wherein the identifier corresponds to the language selected by the user, to obtain, from the respective translations in the electronic file, a translation, in the language selected by the user, for said at least one word (e.g., *when a user accesses system 10 and selects an Administrator page 208 (FIG. 7), logic within the management object that produces page 208 causes management object request processor 156 (FIG. 4) to traverse language directories 204, 205, 206 and determine which languages are available to the user. Each time the user selects Administrator page 208, management object request processor 156 reads all the subdirectories under root directory 220 and looks for the existence of corresponding data files 220en, 220jp, 220fr, e.g., language.txt. The data files 220en, 220jp, 220fr contain information regarding the corresponding languages. When management object request processor 156 locates a language.txt file in a subdirectory, processor 156 presumes that system 10 supports the corresponding language. Subsequently, system 10 displays each of the available languages in a drop down menu box 218 of page 208. (FIG. 7) Drop down menu box 218 presents all available languages in the selected language, e.g., English. Alternatively, drop down menu box 218 may present each available language in that language, e.g., drop down menu box 218 could present the English option in the English language and the Japanese option in the Japanese language. The user can select the desired language in box 218, e.g., with a mouse. If the user selects a new language*

Art Unit: 2176

other than the default language (step 302), such as Japanese) [see fig.7 and the discussion beginning at col.7, line 9 and col.9, line 4].

Note the Examiner's responses above regarding the remaining arguments presented for independent claim 6.

Regarding motivation for combining the cited references:

Applicant argues in substance that the combination of Flanagan and Kennelly fails to establish prima facie obviousness of the invention of independent claims 1 and 6

In response, Examiner notes that the test for the relevance of a cited combination of references is: "whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention," *In re Gorman*, 933 F.2d at 986, 18 USPQ2d at 1888.

Subject matter is unpatentable under section 103 if it would have been obvious ... to a person having ordinary skill in the art.' While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or prior art specifically suggest making the combination: *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988)." Such suggestion or motivation to combine prior art teachings can derive solely from the existence of a teaching, which one of ordinary skill in the art would be presumed to know, and the use of that teaching to solve the same [or] similar problem which it addresses. *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979).

Art Unit: 2176

"In sum, it is off the mark for litigants to argue, as many do, that an invention cannot be held to have been obvious unless a suggestion to combine prior art teachings is found in a specific reference." *In re Oetiker*, 24 USPQ2d 1443 (CAFC 1992).

Regarding dependent claims 2-5 and 7-13:

Applicant did not provide arguments in substance regarding claims 2-5 and 7-13 except for citing the dependencies.

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER